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PATTON BOGGS LLP 1801 CALIFORNIA STREET SUITE 4900 DENVER, CO 80202			EXAMINER BORISSOV, IGOR N	
			ART UNIT 3628	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/610,158

**Applicant(s)**

VEENEMAN ET AL.

**Examiner**

Igor N. Borissov

**Art Unit**

3628

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No./Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Amendment received on 12/10/2007 is acknowledged and entered. Claims 1-8 and 15-29 have been canceled. Claim 9 has been amended. Claims 9-14 are currently pending in the application.

### ***Improper Recapture***

Claims 9-12 are rejected under 35 U.S.C. 251 as being improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed Cir. 1998); *In re Clement* 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir 1997); *Ball Corp. V United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for patent cannot be recaptured by the filing of the present reissue application.

Applicant's broadening of the claims has been considered in light of the prosecution of the parent cases and is seen to be improper recapture. Applicant's arguments of 12 September 1997, repeated in the Preliminary Amendment, argue that the registry serves a plurality of stores in a shopping area, not stores which are in spatially distant areas. Applicant's amendment of 30 June 2000 removes the proximity limitation from both the stores and the registry, which is seen as improper recapture.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Millerv. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 9-14 of this application conflict with claims 1-8, 15-29 of Application No. 10/940,094. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chain Store Age in view of McCalley et al (5,113,496).**

As per Claim 9, 13.

Chain Store Age, which appears to be published in October 1992 (See bottom of the first page), discloses:

a gift registry computer system containing identifying information about a registrant, the information for each registrant including at least the registrant's name and a list of potential gifts which the registrant has identified (page 1 lines 51 - page 2 column 1, line 10);

a portable input and storage device for use by the registrant with a plurality of potential gifts, the input and storage device being capable of receiving and storing information regarding the registrant's desired (page 2 column 1, lines 3-10 and lines 41-48);

a transfer device connected to the computer system that receives the information regarding the registrant's desired gifts from the portable input and storage device and transfers the information to the gift registry computer system (page 2 column 1, lines 6-10);

a prospective purchaser interface device that allows a prospective purchaser to view a list of the goods desired by the registrant wherein the list includes information about the particular merchant each gift is from( page 2 column 3, lines 14-21).

While Chain Store Age discloses the collection of SKU numbers, which can be specific to the merchant and in the case of a store brand and therefore identified with the merchant, just as the bride can scan a generic code, (page 2, column 1, lines 41-49), Chain Store Age does not specifically disclose the unique identifier associated with the particular merchant having each of the desired gifts.

McCalley et al ('496) teaches a system that provides customers with online shopping and gift registry in the electronic mall, (column 22, lines 9-13) for the benefit of increased customer satisfaction and convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Chain Store Age, if necessary, to store and display gift registry associated with different merchants, as taught by McCalley et al ('496) for the benefit of increased customer satisfaction and convenience.

As per Claim 10

Chain Store Age further discloses the portable device is a hand-held scanning device, see page 2, column 1, lines 4-5.

As per Claims 12, 14.

Chain Store Age further discloses an updating means for updating the database storage registrant as a prospective purchaser buys a gift from the list of potential gifts for a potential registrant, see page 2, column 1, lines 49-57.

**Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chain Store Age in view of Parent.**

As per Claims 9, 13

Chain Store Age discloses:

a gift registry computer system containing identifying information about a registrant, the information for each registrant including at least the registrant's name and a list of potential gifts which the registrant has identified (page 1 lines 51 - page 2 column 1, line 10);

a portable input and storage device for use by the registrant with a plurality of potential gifts, the input and storage device being capable of receiving and storing information regarding the registrant's desired (page 2 column 1, lines 3-10 and lines 41-48);

a transfer device connected to the computer system that receives the information regarding the registrant's desired gifts from the portable input and storage device and transfers the information to the gift registry computer system (page 2 column 1, lines 6-10);

a prospective purchaser interface device that allows a prospective purchaser to view a list of the goods desired by the registrant wherein the list includes information about the particular merchant each gift is from (page 2 column 3, lines 14-21).

While Chain Store Age discloses the collection of SKU numbers, which can be specific to the merchant and in the case of a store brand and therefore identified with the merchant, just as the bride can scan a generic code, (page 2, column 1, lines 41-49), Chain Store Age does not specifically disclose the unique identifier associated with the particular merchant having each of the desired gifts.

Parent teaches a mall that provides multi merchant gift registry service to its customers for the benefit of increased customer satisfaction and convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Chain Store Age, if necessary, to store and display a registry for multiple merchants, as taught by Parent for the benefit of increased customer satisfaction and convenience.

As per Claims 10

Chain Store Age further discloses the portable device is a hand-held scanning device, see page 2, column 1, lines 4-5.

As per Claims 12, 14

Chain Store Age further discloses an updating means for updating the database storage registrant as a prospective purchaser buys a gift from the list of potential gifts for a potential registrant, see page 2, column 1, lines 49-57.

**Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chain Store Age in view of Brumback et al.**

As per Claims 9, 13

Chain Store Age discloses:

a gift registry computer system containing identifying information about a registrant, the information for each registrant including at least the registrant's name and a list of potential gifts which the registrant has identified (page 1 lines 51 - page 2 column 1, line 10);

a portable input and storage device for use by the registrant with a plurality of potential gifts, the input and storage device being capable of receiving and storing information regarding the registrant's desired (page 2 column 1, lines 3-10 and lines 41-48);

a transfer device connected to the computer system that receives the information regarding the registrant's desired gifts from the portable input and storage device and transfers the information to the gift registry computer system (page 2 column 1, lines 6-10);

a prospective purchaser interface device that allows a prospective purchaser to view a list of the goods desired by the registrant wherein the list includes information about the particular merchant each gift is from( page 2 column 3, lines 14-21).

While Chain Store Age discloses the collection of SKU numbers, which can be specific to the merchant and in the case of a store brand and therefore identified with the merchant, just as the bride can scan a generic code, (page 2, column 1, lines 41-49), Chain Store Age does not specifically disclose the unique identifier associated with the particular merchant having each of the desired gifts.

Brumback et al teaches a system that provides customers with gift suggestions from several stores in the mall, see page 4, lines 9-13 for the benefit of increased customer satisfaction and convenience.



Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Chain Store Age, if necessary, to store and display gift suggestions associated with different merchants, as taught by Brumback et al for the benefit of increased customer satisfaction and convenience.

As per Claim 10

Chain Store Age further-discloses the portable device is a hand-held scanning device, see page 2, column 1, lines 4-5.

As per Claims 12, 14.

Chain Store Age further discloses an updating means for updating the database storage registrant as a prospective purchaser buys a gift from the list of potential gifts for a potential registrant, see page 2, column 1, lines 49-57.

### ***Response to Arguments***

Applicant's arguments filed 12/10/2007 have been fully considered but they are not persuasive.

Applicant argues that Improper Recapture of claims 9-12 under 35 U.S.C. 251 should be withdrawn because the claims presented in the reissue application do not impermissibly recapture canceled subject matter.

In response to this argument the Examiner maintains that a broadening aspect is present in the current reissue which was not present in the application for a patent. The record of the application for the patent shows that the broadening aspect (in the current reissue) relates to subject matter that applicant *previously surrendered during the prosecution of the application*. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope

surrendered in the application for patent cannot be recaptured by the filing of the present reissue application.

Specifically, Applicant's arguments of 12 September 1997, repeated in the Preliminary Amendment, argue that the registry serves a plurality of stores in a shopping area, not stores which are in spatially distant areas. Applicant's amendment of 30 June 2000 removes the proximity limitation from both the stores and the registry, which is seen as improper recapture. (See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement* 131 F.3d 1464, 45 Uspq2d 1161 (Fed. Cir. 1997); *Ball Corp. V United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

Applicant argues that the Chain Store Age system does not store merchant identification information.

In response to this argument the Examiner points out that McCalley was applied for this feature (See the discussion above).

Applicant argues that there is no suggestion in the McCalley to provide a unified database of gift registry information.

In response to this argument it is noted that the Chain Store Age discloses this feature. To this end Examiner points out that Applicant's arguments are directed against the references individually; but one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that McCalley does not teach that the data entries are distinguished by a "unique identifier associated with the particular merchant having each of the desired gifts,".

In response to this argument the Examiner maintains that McCalley does, in fact teach said feature. Specifically, McCalley discloses said system that provides customers with online shopping and gift registry in the electronic mall (See: column 22, lines 9-13 and the discussion above).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this particular case both references relate to the same application field, electronic commerce. The motivation to modify the reference would be to advantageously increase customer satisfaction and convenience.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/  
Primary Examiner, Art Unit 3628  
06/28/2008